

## **REMARKS**

### **I. Introduction**

In response to the pending Office Action, Applicants have amended claim 6 in order to clarify the subject matter of the invention and to overcome § 112 rejections. Support for the amendments to claim 6 may be found, for example, in Figs. 2 and 5 of the specification. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art.

### **II. The Rejection Of Claims 6, 10-11 and 17-18 Under 35 U.S.C. § 112, First Paragraph**

Claims 6, 10-11 and 17-18 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. Applicants respectfully traverse these rejections for at least the following reasons.

With regard to claims 6, 10, 11 and 17-18, it is alleged that the original specification does not specifically describe how to specify document data of a document including a plurality of different languages to be translated into a plurality of languages and outputted by language groups. It is unclear as to what the Examiner is referring to in this rejection. There is no claim language in any of claims 6, 10, 11 and 17-18 that requires specifying document data of a document. Claims 10 and 17 refer to specifying a plurality of languages or a translated language, respectively. The specification states that the processing unit performs a translation processing in accordance with an instruction concerning information on an after-translation-language setting and a unification mode setting from the operation display unit (see, page 11, lines 8-18). The

setting of the after-translation-language clearly supports the specifying of a plurality of languages.

Furthermore, the limitation “document data of a document” is supported by any of Figs. 2-5, which show documents, for example, paper documents, which contain data. Applicants submit that it is inherent that data contained within a document is “document data”. As such, the Examiner’s rejection is improper and invalid.

It was noted in the “Response to Arguments” section of the pending Office Action that Applicants had failed to respond to the question of enablement. Applicants would like to point out that the Examiner has substantially repeated the § 112 rejection of claims 6, 10, 11 and 17-18 for failing to comply with the written requirement in the § 112 rejection for failing to comply with the enablement requirement. Thus, as the two § 112, first paragraph rejections contain substantially the same language and use substantially the same arguments to support both first paragraph rejections, Applicants submit that the arguments set forth in the previous Response do indeed respond to the enablement rejection.

Furthermore, the Examiner notes “that according to the applicant’s arguments, it appears that a narrow prior art disclosure used by examiner for rejecting a boarder [sic] claim limitation should or would be as part [sic] of the applicant’s invention. This is a wrong logic [sic] and the argument itself is improper.” However, as pointed out in the December 27, 2005 Office Action, the Examiner stated that the limitation “document data” is broad and can be interpreted in many ways, including a single or multiple documents. Thus, the Examiner has admitted that the term “document data” can be interpreted to mean, for instance, “document data of a document”. As such, it is the Applicants who are narrowing the broad scope of a limitation that the Examiner

admitted could be interpreted in many ways. Furthermore, Applicants were not discussing a prior art rejection in the response to the § 112 rejection, nor do the Applicants suggest that they were. As such, Applicants did not “mix them (the rejections) together” as alleged by the Examiner. Lastly, Applicants submit that support for the limitation “document data of a document” may be found, for example, on page 15, lines 5-12 and Fig. 2 which discuss paper documents containing data. Accordingly, Applicants respectfully request that the § 112, first paragraph rejections of claims 6, 10, 11 and 17-18 be withdrawn.

**III. The Rejection Of Claims 6-10 And 17-18 Under 35 U.S.C. § 112, Second Paragraph**

Claims 6-10 and 17-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse these rejections for at least the following reasons.

It was alleged that claim 6 is unclear as to which original language of “a plurality of different languages” is referred to. As such, Applicants have amended claim 6 to recite, in lines 10-11, “each group of the translated document data comprising a printed document in one of the original languages” to overcome this rejection.

Furthermore, it was alleged that if the original language refers to the original copy of document, it conflicts with the limitation of “the translated document data”. However, the claim is clearly not referring to the original copy of the document because the claim recites that the controller “controls said output unit so as to output the translated document data by groups”. There is no mention of any original document in the claim. As such, the Examiner’s statement is invalid.

It was also alleged that claim 17 is indefinite because it is unclear what the specific criterion for grouping is and that it appears that each group is the same as or mixed with the other

group. However, claim 17 refers to a translating apparatus that translates a first and second language into at least one language and then sorts them into groups containing the original language (either the first or second language) and a translation. As is clear, a document containing a first language and a translation would be distinct from a document containing a second language. As such, the limitation “each of the printed documents being distinct from one another” would be satisfied. Accordingly, claim 17 is not indefinite.

In view of the foregoing, Applicants respectively request that the § 112, second paragraph rejection of claims 6-10 and 17-18 be withdrawn.

### **III. The Rejection Of Claims 1, 4-14 and 16-18 Under U.S.C. § 103**

Claims 1, 4-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi et al. (USP No. 5,701,497) in view of Fujita (5,612,872) and Flores et al. (USP No. 6,370,498); and claim 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores, and further in view of Miyahara et al. (USP No. 6,314,213). Applicants respectfully traverse the rejections of the above cited pending claims for at least the following reasons.

With regard to the present invention, claim 1 recites, in-part, a translating apparatus, comprising: translating means for translating document data into another language; an output unit for outputting the translated document data translated by said translating means in printed form...to output the translated document data by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.

Similarly, claim 6 recites, in-part, a translating apparatus, comprising: translating means for translating document data of a document into another language; an output unit for outputting the translated document data translated by said translating means; ... to output the translated document data by groups, each group of the translated document data comprising a printed document in one of the original languages and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.

Furthermore, claim 11 recites, in-part, a translating apparatus wherein, said controller controls said translating means so as to translate each of the first document data and the second document data into a first language and a second language, and controls said output unit so as to output the first and second document data translated into the first language as a first group and the first and second document data translated into the second language as a second group, and claim 14 recites, in-part, wherein, said controller controls said translating means so as to translate the document data in an original language into a first language and a second language, each being different from the original language, and controls said output unit so as to output the document data translated into the first and second languages as a common group of printed documents.

Moreover, amended claim 17 recites, in-part, a translating apparatus wherein, when said input document data includes a first document data written in a first language and a second document data written in a second language, said controller controls said translating means so as to translate said input document data into at least one language, and controls said output unit so as to output the translated input document data by groups, each group of the translated document data comprising printed documents in the original languages and printed documents of the

translated document data translated into said at least one language with each of the printed documents being distinct from one another

Yamauchi and Fujita do not disclose or suggest translating a document and controlling the output unit so as to output the translated document data by groups...with *each of the printed documents being distinct from one another*, as recited in independent claims 1, 6 and 17. Nor do the references suggest any separation or separate grouping of the translated documents from the original documents to make them distinct as disclosed in claims 11 and 14 of the present invention. In contrast, both Yamauchi and Fujita display the original language text and the translated text side-by-side on the same printed document (see, for example, Fig. 24 of Yamauchi and Fig. 2 of Fujita). Thus, the printed document of the original language document or documents and the translated document or documents in the cited prior art are not distinct from one another. As such, Yamauchi and Fujita fail to render claims 1, 6, 11, 14 and 17 obvious. Nor does Flores remedy this deficiency. As is clearly shown in Fig. 3, Flores discloses a printout showing documents (i.e. Work 1, Work 2 and Work 3) that are completely identical. As such, Flores fails to teach or suggest a translating device with each of the printed documents being distinct from one another, or separation or separate grouping of the translated documents from the original documents to make them distinct. Accordingly, Applicants respectfully request that the § 103 rejection of claims 1, 6, 11, 14 and 17 be withdrawn.

As is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As Yamauchi, Fujita, or Flores all fail to disclose the above cited limitations, then based on the foregoing, it is submitted that Yamauchi, alone or in combination with Fujita or Flores does not render claims 1, 6, 11, 14, 17, or any claim dependent thereon obvious.

**IV. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 6, 11, 14 and 17 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.


**V. Conclusion**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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